

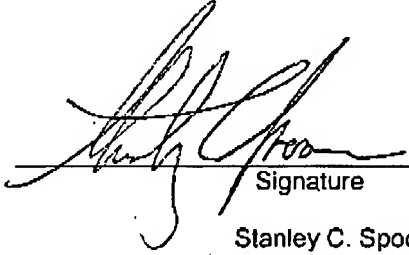
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		SCS-124-1114
Application Number	Filed	RECEIVED CENTRAL FAX CENTER MAY 29 2007
10/533,433	May 2, 2005	
First Named Inventor	JENKINS	
Art Unit	Examiner	
2874	J. Rahll	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> Applicant/inventor <input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> Attorney or agent of record 27,393 (Reg. No.) <input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		



Signature
Stanley C. Spooner

Typed or printed name

703-816-4028
Requester's telephone number

May 29, 2007
Date

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**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Rejection mailed May 26, 2007 (Paper No. 20070219).

Admissions made by the Examiner

In the outstanding Final Rejection on page 2, section 5, the Examiner admits "Jenkins et al. does not describe a means for linearly translating both side walls of the fundamental mode waveguide without substantial distortion." On page 3, lines 4 and 5, the Examiner admits that "Smith does not specifically describe the compression as being 'without substantial distortion', . . ."

These two admissions made by the Examiner in the Final Rejection are critical to the understanding that there is absolutely no support for the Examiner's rejection because no prior art reference or combination of references discloses Applicants' claimed structure.

**Error #1. The Examiner improperly construes the
independent claims "means for linearly translating"**

Each of Applicants' claims 1, 9, 10, 12 and 13 recite a "means for linearly translating" or "means for varying." Because §112 (sixth paragraph) format has been used in the claims, it is incumbent upon the Examiner to review Applicants' specification and interpret each of these claims as requiring the corresponding structure disclosed in Applicants' specification (and equivalents thereto). The corresponding structure is disclosed in Applicants' specification on page 13, lines 8-17 and elsewhere. This specifies that the linear translation and/or varying of the side walls is "without substantial distortion to the shape of the side walls." Applicants'

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specification specifically states “without inducing any significant distortion to its shape” and the subject matter of “its” is “the moveable side wall (or relevant portion of the side wall).”

The Examiner’s failure to properly interpret each of the independent claims 1, 9, 10, 12 and 13 is fatal to his rejection, as it is the claimed subject matter which must be obvious in view of the cited prior art. Therefore, the Examiner’s fundamental failure to properly construe the independent claims is fatal to his rejection of the pending claims 1-10, 12 and 13.

Applicants note that the Examiner has provided no statutory basis for the rejection of claims 12 and 13 and only references claims 1-10 are rejected based upon 35 USC §103 in section 4 on page 2 of the Official Action. While the Examiner does describe and discuss claims 12 and 13 (in sections 15 and 16 of the Official Action), there is no statutory basis for any rejection of these claims and therefore any future rejection is respectfully traversed.

Error #2. The Examiner ignores that Jenkins (U.S. Patent 5,428,698) teaches away from Applicants’ claimed combination

The Examiner’s admission that Jenkins does not describe the claimed “means” is appreciated. This admission clearly obviates any reliance upon Jenkins for a teaching of the claimed “means” in independent claims 1, 9, 10, 12 and 13.

More importantly, Applicants have previously pointed out (in the Amendment filed November 30, 2006) that Jenkins teaches away from the use of a varying cross-section to adjust phases in the fundamental waveguide since Jenkins “teaches the use of electro-optic phase shifters located within the waveguide to accomplish this function.” (prior Amendment, page 8).

Therefore, acknowledgment that Jenkins specifically teaches away from Applicants’ claimed invention would be appreciated.” (as requested in the Amendment, 3rd paragraph, page

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8). Again, the Examiner's acknowledgment that Jenkins teaches away from Applicants' claimed invention is respectfully requested.

Error #3. The Examiner misunderstands Smith (U.S. Patent 7,042,631)

The Examiner's admission that Smith does not teach the claimed "means" in any of Applicants' claims is also appreciated. However, the Examiner's statement at line 6 of page 3 of the Final Rejection regarding "translation of a seawall" is not understood. Applicants will treat the Examiner's statement as intending to mean "translation of a side wall."

The Examiner's argument, as noted above in his errors in claim construction, that lack of distortion of the waveguide is not claimed is simply incorrect. As clearly set out in Applicants' specification, it is distortion of the shape of the movable side wall that is claimed by Applicants' claims. Appellant requested the Examiner, in the fourth full paragraph on page 8 of the previously filed Amendment, to identify any portion of the Smith reference which discloses the claimed "linear translation of both side walls without distortion" as recited in independent claims 1, 9 and 10. The Examiner has failed to identify this structural element of the claims in the cited prior art references.

Because the Examiner admits that both Jenkins and Smith fail to disclose the "means" and because Jenkins teaches away from the claimed "means," there is simply no support for an obviousness rejection of the "means" aspect of Applicants' independent claims. Again, the Examiner is invited to identify any portion of the Jenkins or Smith reference which he believes teaches the claimed "means." Absent such teaching, it is error for the Examiner to conclude that Smith supports any rejection of independent claims 1, 9, 10, 12 or 13.

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**Error #4. The Examiner errs in identifying no "reason"
for combining Jenkins and Smith**

Notwithstanding the Supreme Court's decision in *KSR International*, the Patent Office has mandated (as set out in the Memorandum dated May 3, 2007 by the Deputy Commissioner for Patent Operations, Margaret A. Focarino), that "in formulating a rejection under 35 USC §103(a) based upon a combination of prior art elements, it remains necessary [for the examiner] to identify the reasons why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

The Examiner's conclusory statement that it would be obvious "to use the phase shifting means of Smith et al. with the MMI device of Jenkins" simply does not identify any "reason" for picking and choosing elements, even if one of Smith and Jenkins did contain a disclosure of Applicants' claimed means, which they most certainly do not. The Examiner has certainly not provided any reason why one of ordinary skill would disregard the contrary "electro-optic phase shifter" teachings of Jenkins.

Accordingly, the Examiner has not provided any "reason" why one of ordinary skill in the art would have picked elements from the cited prior art references and combine them in the manner of the rejection. Therefore, there is no basis for a rejection under §103.

SUMMARY

The Examiner admits that neither cited reference discloses the "without substantial distortion" feature of Applicants' claims. The Examiner has apparently failed to properly construe Applicants' independent claims in "means-plus-function" fashion to cover the corresponding structure disclosed in the specification and equivalents thereof. The Examiner, in effect, admits that neither Jenkins nor Smith contain this disclosed structure, i.e., linearly

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translating sidewalls without distortion of their shape. The Examiner identifies no "reason" for combining elements from the Jenkins and Smith references and does not apparently realize that, even if elements were combined, they would not disclose the claimed "means." Finally, the Examiner also ignores the fact that Jenkins teaches away from Applicants' claimed invention.

As a result of the above, there is simply no support for the rejection of Applicants' independent claims 1, 9, 10, 12 or 13 or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.